DETAILED ACTION

Status of the Claims and Examination

Applicants cancelled all previously pending clams without prejudice or disclaimer on 17 June 2009 while concurrently adding new claims 135-188, which are now pending. Claims 135, 137, 146-153, 155, 164-171, 173 and 182-188 are the subject of this Office Action. Claims 136,138-145,154,156-163,172 and 174-181 are withdrawn from consideration as they are drawn to non-elected species. The terminal disclaimers filed December 14, 2007 are acceptable.

Applicant's arguments filed on 17 June 2009 have been fully considered and are, in part, deemed to be persuasive regarding the previous rejection. Rejections and objections not reiterated from this Office's previous action are hereby withdrawn. The rejections set forth herein constitute the complete set of rejections being applied to the instant application presently.

Claim Rejection - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 135, 137, 146-153, 155, 164-171, 173 and 182-188 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,441,038 [hereinafter referred to as "Loder et al"] in view of U.S. Patent No. 6,500,853 B1 [hereinafter referred to as "Seehra et al"].

The teachings and associated arguments over Loder et al and Seehra et al from the Office's previous actions in this case are incorporated herein by reference in their entirety as applicable to the present claims.

Applicants argue that the language consisting essentially of forecloses the administration of any other agent in combination with milnacipran and pregabalin as active agents and that the instant claims are not *prima facie* obvious over the prior art of record. In response, the Examiner takes the position that rather than foreclose the administration of any other agents, the language "consisting essentially of" narrows the scope of the claims to emphasize the prevalence of milnacipran and pregabalin as active agents.

Applicant further argues specifically that one of skill in the art would have had no reason to remove the noradrenaline precursor from Loder's combinations, citing Loder for teaching that administering the noradrenaline reuptake inhibitor in the absence of a noradrenaline precursor is much less effective than the combination. This line of reasoning by Applicant in and of itself supports the Examiner's position for why Loder properly is applied as prior art. The wording "much less effective" suggests that the use of one without the other is nevertheless impactful, which brings the instantly claimed invention within purview.

Applicant also argues that Loder explicitly teaches away from the use of a noradrenaline reuptake inhibitor in the absence of a noradrenaline precursor. In citing to the reference, the Applicant highlights the fact that there is a "strong interaction" and that "phenylalanine can enhance noradrenaline synthesis ..." See Page 16 of Applicant's remarks citing to Loder at Col. 6, line 62 to Col. 7, line 3. This ability of phenylalanine to *enhance* noradrenaline synthesis does not preclude therapeutic effectiveness in phenylalanine's absence.

Applicant also argues that Seehra would have failed to remedy the deficiencies of Loder and as a result, takes the position that there is no need to address the Examiner's contentions with respect thereto.

As noted prior, Loder et al teach that chronic fatigue syndrome, fibromyalgia and perceptive pain associated therewith and depressed mood as known disorders of neurological origin treatable with a drug that "is a compound which inhibits both noradrenaline and serotonin reuptake" (Col. 9, lines 7-9) and more specifically, milnacipran, accompanied by either L-phenylalanine or tyrosine (Col. 9, lines 17-32, claims 1-4).

Seehra et al teach the administration of pregabalin as effective in the treatment of pain, fibromyalgia and chronic fatigue syndrome (Col. 101, lines 23-25; Col. 104, lines 8-10), and that it can be used in combination with other drugs effective in treatment of the same (Col. 102, lines 37-48).

While Loder et al do indeed teach combination therapy, the Applicants construe the same to foreclose the instant reference from reading on the claims of the instant case. The Examiner takes the contrary position that the same is motivation for combining drugs of similar known origin to treat fibromyalgia, pain and chronic fatigue syndrome.

Further, as a matter of law, combining compounds known to individually treat a known disease or disorder would obviously treat the same disease/disorder when combined. *See In re Kerkhoven*. The combination of an effective amount of milnacipran with pregabalin to treat pain, fibromyalgia and chronic fatigue syndrome, for example, would have a reasonable expectation of success.

Other limitations in the disclosed invention relate to dosage form, be they simultaneous, separate or sequential, and capable of oral administration. In the absence of express evidence to the contrary, the same would be discoverable or known by routine optimization by one of ordinary skill in the art.

Further, one of ordinary skill in the art would have been motivated to combine the teachings of Loder et al with the teachings of Seehra et al, because both are directed to the treatment of pain, fibromyalgia and chronic fatigue syndrome and further, the Seehra et al reference does allude to the effectiveness of combination treatments for these conditions.

In light of the foregoing, it would have been *prima facie* obvious to, upon determining the effectiveness of milnacripran and pregabalin to administer the same in combination with each other, to treat pain, fibromyalgia and chronic fatigue syndrome at the time that the instant invention was made.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 7:00 AM to 3:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Public PAIR only. For information about the PAIR system, see http://pair-direct-uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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